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11 Poinsett Ave. #3
Greenville, SC 29601

In re Application of:
William E. James
Application No. 09/674,996
Filed: Nov. 2, 2000
For: Automatically Variable Stride Walk-Run-
Stepper Pedal Exerciser

DECISION ON PETITION
UNDER 37 CFR 1.181 TO
WITHDRAW HOLDING OF
ABANDONMENT

This is a decision on the petitions filed on Jan. 18, 2005, requesting the holding of abandonment be withdrawn in the above-identified application. The petition is considered pursuant to 37 CFR 1.181, and no fee is required for the petition

The petition is **DISMISSED**.

This application was held abandoned for failure to timely file a proper reply to the Office action mailed on Dec. 1, 2003. A Notice of Abandonment was mailed December 13, 2004.

This is a decision on the petition filed on Jan. 18, 2005 by which petitioner requests relief by invoking the Director's supervisory authority to:

1. withdraw the holding of abandonment; and
2. review of the advisory action of Oct. 4, 2004 lead to the holding of abandonment.

Facts in the Record and Facts Presented by Petitioners

A review of the relevant prosecution history shows that the examiner promulgated a first office action on the merits on Feb. 19, 2003 subsequent to the applicant's election of species B in that claims 1-3, 5, 9, 14-16 are readable on the elected species. In the Office action, the examiner rejected claims 1, 2, 5, 6, 15, 16 under 35 USC 102 (b) as anticipated by Rodgers patent, U. S. Pat. 5,989,163. The applicant filed a responsive amendment to the first Office action on the merits on May 23, 2003. The amendment contained numerous changes to the claims. On July 28, 2003, the applicant submitted a supplemental amendment with many changes to the claims with a few additional new claims. On August 4, 2003, the applicant again submitted a second supplement amendment to make changes to the claims with additional new claims. After the receipt of the second supplemental amendment, on Dec. 1, 2003, the examiner issued the final Office action rejecting newly presented claims 22, 23, 26, 27, 36-38 and 40 under 35 USC 102

(b) as anticipated by Rawls et al. U. S. Pat. 5,920,072. The new ground of the rejections in the final Office action was necessitated by the applicant's second supplemental amendment of August 4, 2003. In response to the examiner's final Office action, the applicant filed an amendment after final on March 2, 2004. The examiner issued an advisory action on April 20, 2004 refusing entry of the amendment after final because the amendment did not comply with 37 CFR 1.121 regarding manner of making amendments in applications. In response, on April 30, 2004, the applicant submitted a new amendment after final in compliance with 37 CFR 1.121. Subsequently, on Oct. 10, 2004 in the advisory action the examiner refused to enter the amendment of April 30, 2004 because the amendment did not place the claims in condition for allowance or simplifying issues for appeal. On Dec. 10, 2004, the applicant filed a Notice of Appeal without any extension of time. The period to respond to the final Office action was expired. A notice of abandonment was sent on Dec. 13, 2004 for failure to file a proper response to the final Office action of Dec. 1, 2003.

Petitioner's Position

The petitioner opined that examiner's rejections of the claims are improper and the prior art patent to Rawls does not operate in the same manner as the applicant's claimed device. In particular, there is a difference between the equally weighted, equal and opposite swinging action of a strider in Rawls' device and the applicant's automatic independent pedal return. The Rawls patent simply failed to anticipate the claimed device. The petitioner further disagreed with the examiner's reasons as stated in the advisory action of Oct. 10, 2004.

Applicable Rules and Procedures

37 CFR § 1.113 Final rejection or action states: (a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicant's, or for ex parte reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Reply to a final rejection or action must comply with § 1.114 or paragraph (c) of this section. For final actions in an inter partes reexamination filed under § 1.913, see § 1.953. (b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof. (c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form. Pertinent parts of MPEP 706.07(a) [R-3] Final Rejection; Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). 37 CFR § 1.116 Amendments and affidavits or other evidence after final action and prior to appeal. (a) An amendment after final action must comply with § 1.114 or this section. (b) After a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913, but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title): (1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action; (2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or (3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented. (c) The admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the application or reexamination proceeding from its condition as subject to appeal or to save the application from abandonment under § 1.135, or the reexamination prosecution from termination under § 1.550(d) or § 1.957(b) or limitation of further prosecution under § 1.957(c). (d) (1) Notwithstanding the provisions of paragraph (b) of this section, no amendment other than canceling claims, where such cancellation does not affect the scope of any other

pending claim in the proceeding, can be made in an inter partes reexamination proceeding after the right of appeal notice under § 1.953 except as provided in § 1.981 or as permitted by § 41.77(b)(1) of this title. (2) Notwithstanding the provisions of paragraph (b) of this section, an amendment made after a final rejection or other final action (§ 1.113) in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913 may not cancel claims where such cancellation affects the scope of any other pending claim in the reexamination proceeding except as provided in § 1.981 or as permitted by § 41.77(b)(1) of this title. (e) An affidavit or other evidence submitted after a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913 but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title), may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. (f) Notwithstanding the provisions of paragraph (e) of this section, no affidavit or other evidence can be made in an inter partes reexamination proceeding after the right of appeal notice under § 1.953 except as provided in § 1.981 or as permitted by § 41.77 (b)(1) of this title. (g) After decision on appeal, amendments, affidavits and other evidence can only be made as provided in §§ 1.198 and 1.981, or to carry into effect a recommendation under § 41.50(c) of this title.

37 CFR 1.181(a)(1) states: Petition may be taken to the Director: From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court.

Analysis of Application Record

In the first Office action on the merits, the examiner rejected claims 1, 2, 5, 6, 15, 16 under 35 USC 102 (b) as anticipated by Rodgers patent, U. S. Pat. 5,989,163. The applicant filed a total of three responsive amendments to the first Office action on the merits. Ultimately, claims 1, 2, 5, 6, 15, 16 rejected in the first Office action on the merit were cancelled and new claims 22, 23, 26, 27, 36-38 and 40 were finally rejected under a new prior art patent to Rawls, U.S. Pat. 5,920,072. The new ground of the rejections in the Final Office action was necessitated by the applicant's second supplemental amendment of August 4, 2003 because the newly added claims 27, 26-28 and 40 possess a different scope from the original rejected and cancelled claims 1, 2, 5, 6, 15, 16. According to 37 CFR 1.113 and MPEP 706.07a, the examiner issued the second Office action final appears to be proper because the new ground of rejection was necessitated by the applicant's amendment adding new claims 22, 23, 26, 27, 36-38 and 40.

The propriety of the refusal to enter the amendment after final filed on April 30, 2004 is governed by 37 CFR 1.116. According to this Rule, the examiner's refusal to enter the amendment of after final filed on April 30, 2004 appears to be proper because the amendment does not place the application in condition for allowance or reduce the appealable issue as stated in the advisory action of Oct. 10, 2004.


With regard to the improper rejections given by the examiner, these are appealable issues. Applying the plain language of 37 CFR 1.181(a)(1), it is clear that petitioner's arguments will not support the requested relief, because the relief requested is simply not the type of relief that can be obtained by petition. The issue regarding the examiner's rejections presented by petitioner is clearly directed to the propriety of the examiner's interpretation of the language of the claims and prior art reference, U.S. Pat. 5,920,072 to Rawls and whether the examiner's final rejection of the claims is legally proper in view of the law governing claim interpretation. The question of whether the prior art defeats patentability of claims, or fails to do so when the claim is properly interpreted, or fails to establish prima facie case is clearly an appealable issue. In other words, the question of whether the examiner is right (and if so, whether one or more claims

are unpatentable), or wrong (and the claims are patentable), is a matter for appeal, not for petition.

For the foregoing reasons it appears that the examiner did not abuse his discretion, or act in an arbitrary or capricious manner, in the rejections of claims and the refusal to enter amendment of April 30, 2004. Therefore, there is no basis for granting any of the relief requested. Based on the record, there is also no basis found that the holding of abandonment was improper.

The application is being forwarded to the Supervisory Patent Examiner of Art Unit 3711 for further processing. Petitioner may file a request for reconsideration of this decision, without fee. However, such request must be filed within two months of the date of this decision. Petitioners are reminded that the mere filing of the instant petition or the filing of renewed petition will not stay and period for reply that may be running against the application, nor act as a stay of other proceedings. See 37 CFR 1.181(f). Any inquiry concerning this decision should be directed to Henry Yuen whose telephone is (571) 272-4856.

Accordingly, the petition is **DISMISSED**.



Frederick R. Schmidt, Director
Technology Center 3700